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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,878	02/02/2004	Douglas Rowitch	030186U2	1054

23696	7590	07/18/2007
QUALCOMM INCORPORATED		
5775 MOREHOUSE DR.		
SAN DIEGO, CA 92121		

EXAMINER	
BALAOING, ARIEL A	

ART UNIT	PAPER NUMBER
2617	

NOTIFICATION DATE	DELIVERY MODE
07/18/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/770,878	Applicant(s) ROWITCH ET AL.	
	Examiner Ariel Balaoing	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 04/18/2007 have been fully considered but they are not persuasive.
2. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "Applicant's Background section further describes a desire for "some security to be put in place that would ensure that the mobile station is not triggered by an external device that is not authorized to do so"" (page 5, paragraph 4) and "Poulin fails to teach or suggest that the LBSC has any ability to distinguish one application from another run on the same mobile station" (page 6, paragraph 2)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, while POULIN shows authentication of an application by determining registered subscribers, KRUIS is used in combination with POULIN to provide the limitation "*if the application is not authenticated, then failing to receive at least some information required to run the LBS application*" and therefore teaches the ability to distinguish one application from another.
3. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the real time provisioning taught by KRUIS would benefit POULIN by allowing service validation during activation using a determined mobile identity.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10769,420 in view of KRUIS et al (US 2004/0242209 A1).

Claims 1-7 of the instant application includes all of the limitations of claims 1-7 of copending Application No. 10/769,420 except for:

(From claim 1) e. if the application is not authenticated, then failing to receive at least some information required to run the application in response to the application not being authenticated.

Although the conflicting claims are not identical, they are not patentably distinct from each other. KRUIS teaches wherein if the application is not authenticated, then failing to receive at least some information required to run the application in response to the application not being authenticated (paragraph 53). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the instant invention to include a method to limit information needed to run an application if authentication has failed, as taught by KRUIS, as this provides a safeguard against unnecessary use of system resources. Also it is inherent from copending claim 1 that if the application is not authenticated, then information required to run the application will not be received.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over POULIN et al (US 2002/0115453 A1) in view of KRUIS et al (US 2004/0242209 A1).

Regarding claim 1, POULIN discloses a method for authenticating an application, including: attempting to run a Location Based Service (LBS) application (abstract; paragraph 25); requesting authentication of the LBS application (paragraph 25, 28-30, 36, 62-69; registration and activation required before service can be used. As noted in the applicant's specification, authorization involves verifying of subscribers identity and billing (see paragraph 1004 of the specification). Verification of a subscriber is needed to access proper user profile); communicating directly with a mobile positioning center (MPC) in order to have the MPC [100 – location based service center] fulfill the request for authentication of the LBS application (paragraph 25, 28-30, 36, 62-69; location based service center handles requests from all mobile devices); if the application is authenticated, then receiving within the mobile station information required to continue running the LBS application in response to the application being authenticated (paragraph 62-69, 71-74; once registered, user receives message that registration is complete and location based service requested becomes available). However, POULIN does not expressly disclose if the application is not authenticated, then failing to receive at least some information required to run the LBS application in response to the LBS application not being authenticated. KRUIS discloses if an application is not authenticated, then failing to receive at least some information required to run the LBS application in response to the LBS application not being authenticated (paragraph 53; KRUIS discloses both initial activation and real time management of services provided

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to a mobile station). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify POULIN to include a method to limit information needed to run an application if authentication has failed, as taught by KRUIS, since KRUIS states that such a modification would allow real time management of services (paragraph 11, 12, 15, 16). Also it is inherent that if the application is not authenticated, then information required to run the application will not be received.

Regarding claim 2, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of POULIN and KRUIS further discloses further including: if the application has not been authenticated, receiving a response message indicating that authentication failed (KRUIS – paragraph 53); and in response to receipt of the response message, halting the application (KRUIS – paragraph 53).

Regarding claim 3, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. POULIN further discloses wherein the LBS application that is attempted to run on the mobile station requires authentication from the MPC in order to receive all required information (paragraph 25, 28-30, 36, 62-69).

Regarding claim 4, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. POULIN further discloses wherein the authentication of the LBS application to be run on the mobile station is independent of other authentication operations to be requested by the mobile station for the purpose of authenticating telephone communication (abstract; paragraph 30-33, 62-69; the system of POULIN is used for provisioning of location based services).

Regarding claim 5, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. POULIN further discloses wherein the authentication of the LBS application to be run on the mobile station is further independent of other authentication operations to be requested in order to authenticate other applications (abstract; paragraph 30-33, 62-69; the system of POULIN is used for provisioning of location based services).

Regarding claim 6, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. POULIN further discloses wherein the authentication of the LBS application by the MPC allows the mobile station to communicate with other components (paragraph 40-41, 46, 56-58).

Regarding claim 7, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. POULIN further discloses wherein the other components include a position determination entity [Location Finding Entity, 402].

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ariel Balaoing – Art Unit 2617

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A handwritten signature in black ink, appearing to read 'WT', with a long, sweeping horizontal stroke extending to the right.

**WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600**